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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,049	11/09/2000	Masahito Niikawa	15162/02720	6084
24367	7590	12/30/2004	EXAMINER	
SIDLEY AUSTIN BROWN & WOOD LLP			DAMIANO, ANNE L	
717 NORTH HARWOOD			ART UNIT	PAPER NUMBER
SUITE 3400				
DALLAS, TX 75201			2114	
DATE MAILED: 12/30/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/711,049	NIIKAWA
	Examiner	Art Unit
	Anne L Damiano	2114

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 October 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-40 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 15-17 is/are allowed.
 6) Claim(s) 1-10,14,18,20-31,34 and 36-40 is/are rejected.
 7) Claim(s) 11-13,19,32,33 and 35 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 09 November 2000 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

1. Claims 15-17 are allowed.

Applicant's arguments with respect to claim 15 are persuasive and the rejection of independent claim 15, as well as claims 16 and 17 dependent thereon, has been withdrawn.

2. Claims 11-13, 19, 32, 33 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 1-10, 14, 18, 20-31, 34 and 36-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Woodruff (6,438,711).

As in claim 1, Woodruff discloses a method of diagnosing an electronic device (computer system) which belongs to a customer (field diagnostics and service technician implies that the computer system is customer owned) (column 1: lines 7-10 and line 34-41), said method comprising the steps of:

- a) Receiving an inspection result (diagnostic report) automatically obtained by an inspection program (diagnostic code) by executing the inspection program on said electronic device on said customer side (column 6: lines 44-51, column 7: lines 36-45 and column 8: lines 28-30); and
- b) Obtaining a diagnosis result diagnosing said electronic device on the basis of the inspection result (column 3: lines 10-15 and figure 6). (The diagnostic report is on the basis of the inspection result.)

As in claim 2, Woodruff discloses the method of claim 1, further comprising the step of supplying (downloading to) said inspection program to said customer before said step a). (column 1: lines 45-48, column 3: lines 4-14).

As in claim 3, Woodruff discloses the method of claim 1, further comprising the step of

- c) sending a computer-readable medium carrying said inspection program to said customer, wherein
said step c) is performed before said step a.) (column 7: lines 37-45). (Data is downloaded via a computer-readable medium.)

As in claim 4, Woodruff discloses the method of claim 1, further comprising the step of

d) sending said inspection program to said customer through computer communication

(Ethernet connection), wherein

said step d) is performed before said step a). (column 2: lines 24-29).

As in claim 5, Woodruff discloses the method of claim 4, wherein said inspection program is registered on a server connected to a computer network (column 2: lines 17-18

column 3: lines 4-10 and column 7: lines 26-39) (Various different types of diagnostics are stored on the management console. The system is able to determine which are appropriate for each remote electronic device and then download the appropriate diagnostics to the remote site.

Therefore, each diagnostic must be registered (program must have made itself known at some point) on the server.)

As in claim 6, Woodruff discloses the method of claim 5, wherein

A plurality of inspection programs are registered on said server in accordance with diagnostic items of said electronic device (column 3: lines 4-10 and column 7: lines 26-39).

As in claim 7, Woodruff discloses the method of claim 1, wherein

A computer-readable medium carrying said inspection program result is received in said step a.) (column 3: lines 10-15 and figure 6) (Diagnostic report is sent via a computer-readable medium.)

As in claim 8, Woodruff discloses the method of claim 1, wherein

Said inspection result is received through computer communication in said step a.)

(column 2: lines 24-29).

As in claim 9, Woodruff discloses the method of claim 8, wherein

said step a) including the step of confirming whether data received as an inspection result is a valid inspection result or not (column 6: lines 8-18). (The preliminary diagnostics determines the version of the BIOS. In response to this determination, the appropriate further diagnostics are established. If an invalid version of BIOS were received, it would be determined at this point. Therefore, this step is confirming whether data received is a valid inspection result or not.)

As in claim 10, Woodruff discloses the method of claim 10 further comprising the step of transmitting the diagnosis result to said customer (column 9: lines 8-9).

As in claim 14, Woodruff discloses the method of claim 1, wherein said diagnostic result includes information whether said electronic device needs repair or not (column 3: lines 10-15). (The diagnostic report representing the condition of the computer system implies that whether it needs repair or not is indicated.)

As in claim 18, Woodruff discloses the method of claim 1, wherein said step b) is performed by a computer (column 3: lines 10-15).

As in claim 20, Woodruff discloses a method of diagnosing an electronic device (computer system), which belongs to a customer (field diagnostics and service technician implies that the computer system is customer owned) (column 1: lines 7-10 and line 34-41), comprising the steps of:

- a) Receiving a computer readable medium carrying an inspection result obtained by executing an inspection program (diagnostic code) on said electronic device on said customer's side (column 6: lines 44-51, column 7: lines 36-45 and column 8: lines 28-30) (column 7: lines 37-45). (Data is downloaded via a computer-readable medium.); and
- b) Reading out the inspection result (diagnostic report) from the computer-readable medium (column 3: lines 10-15 and figure 6). (The diagnostic report is on the basis of the inspection result.)

As in claim 21, Woodruff discloses the method of claim 20, further comprising the step of

- c) sending said computer-readable medium carrying said inspection program to said customer, wherein
said step c) is performed before said step a). (column 1: lines 45-48, column 3: lines 4-14).

As in claim 22, Woodruff discloses a method of diagnosing an electronic device (computer system), which belongs to a customer (field diagnostics and service technician implies

that the computer system is customer owned) (column 1: lines 7-10 and line 34-41), comprising the steps of:

- a) Receiving an inspection result through computer communication, said inspection result obtained automatically by an inspection program by executing the inspection program on said electronic device on said customer's side (column 2: lines 24-29, column 6: lines 44-51, column 7: lines 36-45 and column 8: lines 28-30) (column 7: lines 37-45). (Data is downloaded via a computer-readable medium.); and
- b) Preparing for reading out the inspection result (diagnostic report) from the computer-readable medium (column 3: lines 10-15 and figure 6). (The diagnostic report is on the basis of the inspection result.)

As in claim 23, Woodruff discloses the method of claim 22, further comprising the step of

- c) Transmitting said inspection program to said customer through computer communication (column 2: lines 24-29), wherein, said step c) is performed before said step a). (column 1: lines 45-48, column 3: lines 4-14).

As in claim 24, Woodruff discloses the method of claim 23, further comprising the step of

- d) accepting the selection of an inspection program out of a plurality of inspection programs from said customer; where

said step d) is performed before said step c). (column 2: lines 17-18 column 3: lines 4-10 and column 7: lines 26-39) (Various different types of diagnostics are stored on the management console. The system is able to determine which are appropriate for each remote electronic device and then download the appropriate diagnostics to the remote site. When the appropriate diagnostics are downloaded to the remote computer system, they are accepted by the customer.)

As in claim 25, discloses a method of serving an inspection program for an electronic device (computer system) which belongs to a customer (field diagnostics and service technician implies that the computer system is customer owned) (column 1: lines 7-10 and line 34-41) through computer communication, the method comprising the steps of:

a) Registering a plurality of inspection programs on a server, the plurality of inspection programs corresponding to a plurality of functions of the electronic device, respectively (column 2: lines 17-18 column 3: lines 4-10 and column 7: lines 26-39) (Various different types of diagnostics are stored on the management console. The system is able to determine which are appropriate for each remote electronic device and then download the appropriate diagnostics to the remote site. Therefore, each diagnostic must be registered (program must have made itself known at some point) on the server.)

b) Accepting selection of an inspection program out of the plurality of inspection programs from the customer (column 2: lines 17-18 column 3: lines 4-10 and column 7: lines 26-39) (Various different types of diagnostics are stored on the management console. The system is able to determine which are appropriate for each remote electronic device and then download

the appropriate diagnostics to the remote site. When the appropriate diagnostics are downloaded to the remote computer system, they are accepted by the customer.); and

c) Accepting download of the inspection program selected in step b) (column 7: lines 37-45).

Wherein the inspection program is adapted for execution on the electronic device on the customer's side so as to obtain an inspection result automatically (column 6: lines 44-51, column 7: lines 36-45 and column 8: lines 28-30).

As in claim 26, Woodruff discloses a method of serving an inspection program for an electronic device (computer system), which belongs to a customer (field diagnostics and service technician implies that the computer system is customer owned) (column 1: lines 7-10 and line 34-41), said method comprising the steps of:

a) Preparing an inspection program (column 2: lines 17-18 column 3: lines 4-10 and column 7: lines 26-39) (Various different types of diagnostics are stored on the management console. The system is able to determine which are appropriate for each remote electronic device and then download the appropriate diagnostics to the remote site.); and

b) Supplying (downloading) said inspection program to said customer (column 7: lines 37-45),

Wherein an inspection result is generated by execution of said inspection program on said electronic device on said customer's side under so as to obtain the inspection result automatically, and diagnosis of said electronic device is performed on the basis of said inspection result (column 6: lines 44-51, column 7: lines 36-45 and column 8: lines 28-30).

As in claim 27, Woodruff discloses an apparatus for diagnosing an electronic device (computer system) through computer communication, the electronic device belonging to a customer (field diagnostics and service technician implies that the computer system is customer owned) (column 1: lines 7-10 and line 34-41), the apparatus comprising;

A receiving circuit for receiving an inspection result (diagnostic report) obtained automatically by an inspection program by executing the inspection program on said electronic device on the customer's side (column 6: lines 44-51, column 7: lines 36-45 and column 8: lines 28-30); (Some type of circuit must be existent to complete the receiving.) and

A processor for obtaining a diagnosis result by diagnosing the electronic device on the basis of the inspection result (column 3: lines 10-15 and figure 6). (The diagnostic report is on the basis of the inspection result.)

As in claim 28, Woodruff discloses the apparatus of claim 27, wherein
Said processor compares a value in said inspection result with a predetermined threshold value (column 3: lines 10-15). (The diagnostic report representing the condition of the system implies that inspection results are compared with predetermined threshold values.)

As in claim 29, Woodruff discloses the apparatus of claim 27, wherein
Said processor calculated a value for diagnosis from said inspection result, and compares said value for diagnosis with a predetermined threshold value, to thereby judge whether said electronic device needs repair or not (column 3: lines 10-15). (The diagnostic report

representing the condition of the system implies that a value for diagnosis is calculated and inspection results are compared with predetermined threshold values.)

As in claim 30, Woodruff discloses the apparatus of claim 27, wherein

Said processor judges whether data received as an inspection result is a valid inspection result or not (column 6: lines 8-18). (The preliminary diagnostics determines the version of the BIOS. In response to this determination, the appropriate further diagnostics are established. If an invalid version of BIOS were received, it would be determined at this point. Therefore, this step is confirming whether data received is a valid inspection result or not.)

As in claim 31, Woodruff discloses the apparatus of claim 27, further comprising

A transmitting circuit for transmitting said diagnostic result toward said customer (column 2: lines 21-24 and column 9: lines 8-9).

As in claim 34, Woodruff discloses the apparatus of claim 27, wherein

Said diagnosis result includes information whether said electronic device needs repair or not (column 3: lines 10-15). (The diagnostic report representing the condition of the computer system implies the it includes whether the computer system needs repair or not.)

As in claim 36, Woodruff discloses an apparatus for serving an inspection program for an electronic device (computer system) through computer communication, the electronic device

belonging to a customer (field diagnostics and service technician implies that the computer system is customer owned) (column 1: lines 7-10 and line 34-41), the apparatus comprising:

A receiving circuit for receiving messages from the customer; and
A processor for registering a plurality of inspection programs corresponding to a plurality of functions of the electronic device, respectively, accepting selection of an inspection program out of the plurality of programs, and accepting download of the inspection program selected by the customer (column 2: lines 17-18 column 3: lines 4-10 and column 7: lines 26-39) (Various different types of diagnostics are stored on the management console. The system is able to determine which are appropriate for each remote electronic device and then download the appropriate diagnostics to the remote site. Therefore, each diagnostic must be registered (program must have made itself known at some point) on the server.),
Wherein the inspection program is adapted for execution on the electronic device on the customer's side so as to obtain an inspection result automatically (column 6: lines 44-51, column 7: lines 36-45 and column 8: lines 28-30).

As in claim 37, Woodruff discloses a computer-readable medium carrying a program for diagnosing an electronic device through computer communication, the electronic device belonging to a customer (field diagnostics and service technician implies that the computer system is customer owned) (column 1: lines 7-10 and line 34-41), wherein execution of the program by a computer causes the computer to perform a process comprising the steps of:

a) Receiving an inspection result automatically obtained by an inspection program by executing the inspection program (diagnostic code) on the electronic device on the customer's side (column 6: lines 44-51, column 7: lines 36-45 and column 8: lines 28-30); and

b) Obtaining a diagnosis result by diagnosing the electronic device on the basis of the inspection result (column 3: lines 10-15 and figure 6). (The diagnostic report is on the basis of the inspection result.)

As in claim 38, Woodruff discloses the computer-readable medium of claim 37, wherein

Said computer-readable medium is a hard disk system connected to a server on a computer network (column 6: line 63-column 7:line 5).

As in claim 39, Woodruff discloses a computer-readable medium carrying a program for serving an inspection program for an electronic device through computer communication, the electronic device belonging to a customer, wherein execution of the program by a computer causes the computer to perform a process comprising the steps of:

a) Registering a plurality of inspection programs on a server, the plurality of inspection programs corresponding to a plurality of functions of the electronic device, respectively (column 2: lines 17-18 column 3: lines 4-10 and column 7: lines 26-39) (Various different types of diagnostics are stored on the management console. The system is able to determine which are appropriate for each remote electronic device and then download the appropriate diagnostics to the remote site. Therefore, each diagnostic must be registered (program must have made itself known at some point) on the server.)

b) Accepting selection of an inspection program out of the plurality of inspection programs from the customer (column 2: lines 17-18 column 3: lines 4-10 and column 7: lines 26-39); (Various different types of diagnostics are stored on the management console. The system is able to determine which are appropriate for each remote electronic device and then download the appropriate diagnostics to the remote site. When the appropriate diagnostics are downloaded to the remote computer system, they are accepted by the customer.) and

c) Accepting download of the inspection program selected in step b) (column 7: lines 37-45).

Wherein the inspection program is adapted for execution on the electronic device on the customer's side under instruction from the customer (column 6: lines 44-51, column 7: lines 36-45 and column 8: lines 28-30).

As in claim 40, Woodruff discloses the computer-readable medium of claim 39, wherein said computer-readable medium is a hard disk system connected to a server computer network (column 6: line 63-column 7:line 5).

Response to Arguments

5. Applicant's arguments, see Request for Continued Examination, filed 10/22/04, with respect to the rejection(s)of claim(s) 1-10, 14, 18, 20, 21-27, 30, 31, 34 and 36 under Griffin have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of Woodruff (6,438,711).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne L Damiano whose telephone number is (571) 272-3658.

The examiner can normally be reached on M-F 9-6:30 first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on (571) 272-3645. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALD



SCOTT BADERMAN
PRIMARY EXAMINER